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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/404,047	09/23/1999	PRADEEP IYER	AVERP2511USA	7985

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EXAMINER

LEE, RIP A

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 09/24/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/404,047

Applicant(s)

IYER ET AL.

Examiner

Rip A. Lee

Art Unit

1713

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-46 and 58-60.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: attachment to advisory action

***Attachment to Advisory Action***

1. This advisory action follows an after-final response filed on August 15, 2003.
2. Applicants traverse the rejections of claims under 35 U.S.C. 102(b) as being anticipated by Mallya *et al.* and Plamthottam *et al.* Reasons for the rejections have been elaborated in detail in the previous office actions, and therefore, they will not be repeated here. The examiner does not concur with the notion that the prior art does not teach the subject matter of the present claims. The essential features of present claim 1 and of the parent claims of Mallya *et al.* and Plamthottam *et al.* have been juxtaposed below:

**Present Claim 1**

- (a) major amount of (meth)acrylate ester
- (b) 8-30 wt % of N-containing monomer
- (c) 0.15-15 wt % of unsaturated carboxylic acid
- (d) 1+ crosslinkable monomer

**Mallya *et al.***

- (a) 55-85 wt % of (meth)acrylate ester
- (b) 1-10 wt % of N-vinyl lactam
- (c) 0-15 wt % of unsaturated carboxylic acid
- (d) 0.01-2 wt % of glycidyl monomer

**Present Claim 1**

- (a) major amount of (meth)acrylate ester
- (b) 8-30 wt % of N-containing monomer
- (c) 0.15-15 wt % of unsaturated carboxylic acid
- (d) 1+ crosslinkable monomer

**Plamthottam *et al.***

- (a) 55-85 wt % of (meth)acrylate ester
- (b) 0-30 wt % of activator moiety
- (c) up to 15 wt % of unsaturated carboxylic acid
- (d) 0.01-2 wt % of glycidyl methacrylate ester

In particular, dependent claim 3 of Plamthottam *et al.* indicates that activator component (b) is N-vinyl pyrrolidone. The glycidyl monomer adequately qualifies as crosslinkable monomer.

As stated above, dependent claims describe meaningful developments of each invention, and their relevance to the present application has been discussed in detail previously. Clearly, one can see that the subject matter of the present claims is, indeed, disclosed in the prior art.

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3. Applicants also traverse the rejection of claims, in particular, claim 25 and claims depending therefrom, under 35 U.S.C. 102(b) as being anticipated by Mallya *et al.* and Plamthottam *et al.* The Applicants submit that the rejection lacks proper basis because the prior art does not disclose a blend of materials. However, the claim is directed to a pressure sensitive adhesive, not a blend, *per se*. The combination of materials still results in an overall pressure sensitive adhesive composition that is essentially the same as that presently claimed. Since the PSA composition is a homogenous mixture of materials, and the instant application provides no reason to believe it is not, its constitution is the sum of all ingredients used to make up the overall composition, and one would not be able to differentiate the individual ingredients. Furthermore, the overall composition would not be independent on how materials were combined.

4. In view of the discussion above, the rejections of record have not been withdrawn.

5. Applicants traverse the rejection of claims 58-60 under 35 U.S.C. 112, first paragraph, as allegedly containing new subject matter. It was deemed that there was no support in the application for the claimed 12-30 wt % range of component (b). Upon further review, the recited ranges 8-30 wt % and 12-15 wt % (specification, pages 6 and 7) appear adequate to support such a claim. As such, the rejection of record has been withdrawn.

6. The newly recited range of 12-30 wt % would not render the claim novel since this range still lies squarely within the allowed range cited in the prior art. As such, claims 58-60 would be rejected under 35 U.S.C. 102(b) to Mallya *et al.* or Plamthottam *et al.*

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

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September 16, 2003



DAVID W. WU  
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